

**To:** Shrinivas Sugandhalaya ([pctrademarks@perkinscoie.com](mailto:pctrademarks@perkinscoie.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 78691247 - NAG CHAMPA - 80171.4000.0  
**Sent:** 7/13/2015 1:53:07 PM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 78691247

**MARK:** NAG CHAMPA

**\*78691247\***

**CORRESPONDENT ADDRESS:**

JAMES L. VANA  
PERKINS COIE LLP  
1201 THIRD AVENUE, SUITE 4900  
SEATTLE, WA 98101

**CLICK HERE TO RESPOND TO THIS LETTER**  
<http://www.uspto.gov/trademarks/teas/response>

[VIEW YOUR APPLICATION FILE](#)

**APPLICANT:** Shrinivas Sugandhalaya

**CORRESPONDENT'S REFERENCE/DOCKET NO. :**

80171.4000.0

**CORRESPONDENT E-MAIL ADDRESS:**

[pctrademarks@perkinscoie.com](mailto:pctrademarks@perkinscoie.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 7/13/2015

**THIS IS A FINAL ACTION.**

This Office Action replies to applicant's response dated May 22, 2015. In its response applicant again argued against the denial of the claim of acquired distinctiveness under Section 2(f). The examining attorney has considered the applicant's arguments and evidence carefully but is not persuaded by the arguments or the sufficiency of the supporting evidence. As such, the final refusal based on Descriptiveness under Section 2(e)(1), issued 6/10/13, is again maintained and the refusal of the claim of Acquired Distinctiveness under Section 2(f) is now made **FINAL**.

**Claim of Acquired Distinctiveness under Section 2(f) is Insufficient:**

As part of applicant's request for reconsideration of the descriptiveness/generic Final refusal issued 6/10/13, the applicant made a claim of Acquired Distinctiveness under Section 2(f) of the Trademark Act based on five years use and additional supporting statements and evidence. Once properly raised the Section 2(f) claim was rejected as being insufficient.

In support of the 2(f) claim the applicant's provided a verified claim of acquired distinctiveness as to the wording "NAG CHAMPA" comprising the entire proposed mark based on applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement" and "United States sales of incense under the mark [NAG CHAMPA] from the year 1994 to March 2013". See 37 C.F.R. §2.41.

However, as previously advised in the two previous Office Actions, the Section 2(f) claim based on five years use is insufficient to show acquired distinctiveness because the words "NAG CHAMPA" in the applied-for mark are highly descriptive of applicant's goods and the applicant does not appear to have substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

**Highly Descriptive:**

The 2(f) claim is not acceptable because the proposed mark is highly descriptive in relationship to the goods identified in the application. As the previously attached evidence clearly demonstrated, the allegation of five years' use is insufficient to show acquired distinctiveness because the applied-for mark is highly descriptive of applicant's goods. *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989); TMEP §1212.05(a).

**Use Not Substantially Exclusive:**

Additionally, the claim is not acceptable because use of the proposed mark is not substantially exclusive. As the attached and previously attached evidence demonstrates, the use of the proposed mark is not substantially exclusive as required under TMEP § 1212.05(b). The examining attorney has provided significant evidence of third party use of the proposed mark to identify the same goods and also to indicate and identify the fragrance or scent of those goods as well as the fragrance or scent of candles, aromatherapy oils, oils and other fragranced or scented goods. This evidence clearly shows that the applicant's use of the proposed mark is not substantially exclusive as required for a claim of Acquired Distinctiveness under Section 2(f).

In its Request for Reconsideration applicant acknowledges that the "examiner provided evidence of occasional third party use" and that the applicant has "taken numerous steps to address and stop such third party activity, including sending demand letters to parties filing applications to register marks containing the Mark,...". Applicant also claims that the third party use does not precede that of applicant. While this may all be true the record is replete with numerous and multiple examples of independent third party use of the proposed mark for identical goods and highly related goods. The evidence of record clearly shows that independent third party use is in fact substantial and not occasional. The existence of numerous third party users of the mark, even if junior to the applicant's use, has a material impact on the Applicant's claim distinctiveness. See *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987) Therefore, under such circumstances an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking.

## Burden of Proof

When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. Thus, applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

Additionally, the amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Bd. of Trs. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970)); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010); see TMEP §1212.05(a). The more descriptive a term is, the greater applicant's evidentiary burden to establish acquired distinctiveness becomes. See, e.g., *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4 (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d at 1581, 6 USPQ2d at 1008); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013).

In response to the denial of the proposed mark based on the statutory five years use the applicant provided additional evidence for consideration.

### Affidavit:

Applicant provided a single personal affidavit from applicant's general manager. This affidavit discusses the purported origin of the proposed mark, provides overall worldwide and North American sales figures and testifies to the proposed marks use over eighteen plus years in North America.

### Sales Figures:

Applicant provided information regarding its sales figures over the years. Such evidence is not dispositive of whether the words "NAG CHAMPA" in the proposed mark have acquired distinctiveness. Rather, such sales information may demonstrate the commercial success of applicant's goods, but not that relevant consumers view the matter as a mark for such goods. See *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

### Advertising figures & Samples of Advertising:

Applicant provided no advertising figures, nor any samples of advertising for consideration of the use of the proposed mark in establishing distinctiveness of the mark as an indicator of source.

### Consumer or dealer statements of recognition of the mark as a source identifier:

Applicant provided no consumer or dealer statements of recognition of the proposed mark as a source identifier for consideration in establishing distinctiveness of the mark as an indicator of source.

### Other evidence:

Applicant provided no other evidence for consideration in establishing distinctiveness of the mark as an indicator of source.

## Examining Attorneys Supporting Evidence:

As noted in the previous Actions, the proposed mark is comprised of the descriptive wording “NAG CHAMPA”. The proposed mark merely describes a key feature and/or characteristic of the identified goods; namely, Indian fragrances incorporated into incense and related fragrance products. See the sample of LexisNexis® articles attached hereto and the sample of Internet printouts and third-party registration attached to the Action mailed June 10, 2013 and attached hereto.

Applicant now claims that this wording has acquired distinctiveness in relation to the identified goods under Trademark Act Section 2(f). However, as noted in the Office Action mailed October 19, 2012 and again in the Final Office Action of June, 10, 2013, the wording “NAG CHAMPA” is generic in relation to the goods. To support this position, the examiner properly made of record several Internet printouts demonstrating the generic nature of the wording “NAG CHAMPA” in relation to incense and fragrance-related products. The examining attorney now attaches additional evidence consisting of multiple LexisNexis® articles showing generic use of NAG CHAMPA.

Applicant argued that the examiner’s evidence was deficient because “[t]he Internet articles submitted by the Examiner were not obtained from a competent source”. Thus, according to applicant, “the articles downloaded from the Internet should be treated as having limited probative value because the source of each article is unknown.”

In response, the applicant was advised that material obtained from the Internet is generally accepted as competent evidence. See *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Furthermore, in the October 24, 2014 Action, applicant’s was provided multiple Internet printouts, LexisNexis® articles and an article from the online ProQuest Dialog database showing generic use of the wording “nag champa” with incense and fragrance-related products. This evidence supplemented the previous evidence made of record.

Of noteworthy significance the October 24, 2014 Action included the glossary entries from [www.nstperfume.com](http://www.nstperfume.com) and [www.theperfumecourt.com](http://www.theperfumecourt.com) showing the wording “Nag Champa” refers to “perfume oil originally made in the Hindu and Buddhist monasteries of India and Nepal and used to perfume incense”. These entries further explain that nag champa was “[t]raditionally made from a sandalwood base, to which are added a variety of flower oils, including that from the flower of the Champaca tree.” Additionally, one of the newly attached articles states “Though often mistaken for a brand name, “Nag Champa” is really the name of a specific combination of natural fragrance ingredients associated with the Ayurvedic tradition. Though most famously known as a popular type of incense, Nag Champa scents are used in a variety of scent products ranging from practical items to various means of delivering the ambient fragrance into the space of a room. If you’re a fan of Nag Champa, you can easily incorporate it into many areas of your daily life.”

Again material obtained from computerized text-search databases, such as LexisNexis®, is generally accepted as competent evidence. See *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (accepting LexisNexis® evidence to show descriptiveness); TBMP §1208.01; TMEP §710.01(a)-(b). Even if the Board considered the examiner’s Internet evidence from [www.ebay.com](http://www.ebay.com), [www.ehow.com](http://www.ehow.com) and [www.ezinearticles.com](http://www.ezinearticles.com) similar to articles from the online Wikipedia® encyclopedia, the examiner has

taken the “better practice” approach of corroborating such evidence with information from other reliable sources, including LexisNexis® and other online sources. *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032-33 (TTAB 2007); TBMP §1208.03; TMEP §710.01(b). Therefore, applicant’s comment that the examiner’s evidence should be disregarded “because the printouts consist of casual, non-purchasing uses of ‘Nag Champa’,” is misguided and unpersuasive.

In response to applicant’s allegation that the examiner’s evidence merely demonstrates that other “parties infringe on [its] rights”, applicant’s claim of priority of use is not relevant to this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Furthermore, the examiner cannot simply turn a blind eye to the evidence of record, including the LexisNexis® and ProQuest Dialog articles and Internet printouts showing generic use of the wording “nag champa” and “nag champa incense” by third parties.

Applicant also disputes the value of the third-party registration made of record showing the wording “NAG CHAMPA” disclaimed from the registered mark PPURE NAGCHAMPA because “third-party registrations are not conclusive on the question of descriptiveness or genericness.”

However, third-party registrations featuring goods the same as or similar to applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

Moreover, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987); TMEP §1207.01(d)(iii).

Finally, contrary to applicant’s comments in the first footnote of the September 3, 2014 response regarding a lack of “LexisNexis® articles and third-party registrations attached to the previous Office Actions”, a closer review of these Actions clearly shows a sample third-party registration showing the wording “NAG CHAMPA” disclaimed from the registered mark PPURE NAGCHAMPA in U.S. Registration No. 4073674. Additionally the examining attorney attached multiple LexisNexis® articles showing generic use of the wording “nag champa” and “nag champa incense”. *See the LexisNexis® articles attached to the October. 24, 2014 response and other evidence of items 1 and 2 mentioned above previously attached to other Office Actions.*

### **Conclusion:**

Based on the foregoing, the claim of Acquired Distinctiveness under Section 2(f) is denied as insufficient and the refusal is now made FINAL.

### **Maintaining Descriptive/Generic Refusal:**

The Descriptive/Generic FINAL Refusal under Section 2(e)(1), issued 6/10/13, is again maintained. Furthermore, if the wording “NAG CHAMPA” in the applied-for mark is ultimately determined not to be generic by an appellate tribunal, then the refusal to register the proposed mark because it is merely descriptive under Section 2(e)(1) is maintained and continued for the reasons specified in previous Office actions and the FINAL Office Action addressing that grounds from 6/10/13. Trademark Act Section

2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

### **Responding to a FINAL Refusal:**

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements and/or resolves all outstanding refusals.
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.63(b)(1)-(2); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

### **To Respond To This Letter:**

Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

### **Who Must Sign The Response:**

It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

### **Periodically Check The Status of the Application:**

To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

### **To Update Correspondence/e-mail Address:**

Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

/JSD/

Jeffrey S. DeFord  
Examining Attorney  
Law Office 115  
571 272-9469  
jeffrey.deford@uspto.gov

**To:** Shrinivas Sugandhalaya ([pctrademarks@perkinscoie.com](mailto:pctrademarks@perkinscoie.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 78691247 - NAG CHAMPA - 80171.4000.0  
**Sent:** 7/13/2015 1:53:08 PM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON **7/13/2015** FOR U.S. APPLICATION SERIAL NO. 78691247

Please follow the instructions below:

**(1) TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

**(2) TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **7/13/2015** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

**Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response** because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

**(3) QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

**WARNING**

**Failure to file the required response by the applicable response deadline will result in the**

**ABANDONMENT of your application.** For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).